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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/501,343

07/26/2004

Hansulrich Reisacher

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05/16/2006

EXAMINER

HAILEY, PATRICIA L

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.

1940 DUKE STREET

ALEXANDRIA, VA 22314

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/501,343	<b>Applicant(s)</b> REISACHER ET AL.	
	<b>Examiner</b> Patricia L. Hailey	<b>Art Unit</b> 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/15/06</u> . | 6) <input type="checkbox"/> Other: _____  |

Applicants' remarks and amendments, filed on February 15, 2006, have been carefully considered. No claims have been canceled or added; claims 1-12 remain pending in this application.

As stated by Applicants, support for the amendment to claim 1 can be found in the Specification at page 2, lines 15 and 16.

***Withdrawn Rejection***

The 112(2) rejection of claim 9, stated in the previous Office Action, has been withdrawn in view of Applicants' amendment thereto.

***Maintained Rejections***

The following rejections of record have been maintained; the text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Double Patenting***

1. ***Claims 1-12 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/515,345.***

Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to pigment preparations

comprising a pigment, at least one anionic surface active agent, and at least one nonionic surface active agent, each of which are comparable to one another.

See, for example, claims 1-5 in the instant application and claim 1 of the '345 application, with respect to the anionic surface active agent.

Additionally, the respective sets of claims correspond to one another as follows: Instant Claims 6-11 correspond to claims 4-20 in the '345 application, and Instant Claim 12 corresponds to claims 2 and 3 in the '345 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### *Claim Rejections - 35 USC § 112*

2. *Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

The claims are indefinite because the percentage ranges recited in claim 1 are not commensurate with the claim's requirement that the sum total of the weight percentages are not to exceed 100% by weight (as recited in the last line of claim 1). For example, if component (A) is employed at its maximum percentage of 90%, the percentage ranges of components (B) and (C) do not total 10% or less, based on the recited percentage ranges for these components. Further, it cannot be readily

determined if all of these weight percentages are based on the total weight of the pigment preparations, or, for example, if the percentages of components (B) and (C) are based on the total weight of the pigment (i.e., component (A)).

*Claim Rejections - 35 USC § 102*

3. *Claims 1-5, 7-10, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Gonzalez-Blanco et al. (U. S. Patent No. 6,110,266).*

Gonzalez-Blanco et al. teach pigment preparations comprising at least one pigment, at least one dispersant, and water. See the Abstract of Gonzalez-Blanco et al., as well as col. 1, lines 30-40.

Exemplary pigments, preferably used in an amount of 0.05 to 80% by weight, relative to the pigment preparation, are disclosed at col. 1, line 45 to col. 2, line 46 of Gonzalez-Blanco et al.

Examples of the dispersant include non-ionic and anionic compounds. Exemplary non-ionic compounds include reaction products of alkylene oxides with alkylatable compounds such as fatty alcohols and fatty amines (considered to read upon component (B) in Applicants' claims); exemplary anionic compounds include alkyl sulfates, ether sulfates, and phosphate esters (considered to read upon component (C) in Applicants' claims, as well as the limitation "ether phosphates"). See col. 2, line 47 to col. 5, line 48 of Gonzalez-Blanco et al.

The dispersant is preferably used in an amount of 0.1 to 200% by weight, relative to the weight of pigments used. See col. 5, lines 49-51 of Gonzalez-Blanco et al.

At col. 6, line 34 to col. 7, line 12, Gonzalez-Blanco et al. disclose the feasibility in employing additional colorants, such as carbon blacks, organic coloring pigments (from the azo, diazo, polyazo, anthraquinone, and thioindigo series), etc., in the aforementioned pigment preparations. These additional colorants can be present in the pigment preparations in amounts ranging from 0 to 80% by weight, relative to the pigment preparation (col. 7, line 66 to col. 8, line 8).

The pigment preparations are prepared for use in printing inks for ink-jet printing by homogenizing the pigment with any optional colorant, at least one portion of the dispersant, and, if desired, with further additives, and optionally subjecting the resultant mixture to dry or wet crushing. See col. 8, lines 26-32 of Gonzalez-Blanco et al.

Alternative methods include introducing and homogenizing the pigment, optional water-soluble colorants, a portion of the dispersant, and water in a stirred vat, dissolver, or similar device, until a homogeneous milled suspension is obtained. See col. 8, lines 57-64 of Gonzalez-Blanco et al., as well as col. 9, lines 5-41, which discusses wet-crushing of the pigment and, if desired, colorants, as well as, in a dilution step, mixing the pigment preparation in water with any remaining amounts of dispersant, and homogenizing the resultant mixture, which is brought to the desired final pigment concentration and color strength of the preparation or printing ink. During this step, it

may be desirable to add another portion of dispersant, to avoid reagglomeration of the fine pigment particles in dilution.

In view of these teachings, Gonzales-Blanco et al. anticipate claims 1-5, 7-10, and 12.

*Claim Rejections - 35 USC § 103*

4. *Claims 6 and 11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzalez-Blanco et al. (U. S. Patent No. 6,110,266) in view of Nyssen (U. S. Patent No. 6,646,023).*

Gonzalez-Blanco et al. is relied upon for its teachings as stated in the above 102(b) rejection. Although this reference teaches pigment preparations that read upon claims 1-5, 7-10, and 12, as addressed above, this reference does not explicitly teach the claimed properties of particle size and surface area, as recited in claims 6 and 11.

Nyssen teaches pigment preparations comprising at least one organic or inorganic pigment and at least one compounds selected from, inter alia, reaction products of alkylene oxides with alkylatable compounds such as fatty alcohols). See col. 2, lines 41-50 of Nyssen; note that these components are also disclosed in Gonzalez-Blanco et al. as stated above.

The preparations of Nyssen are also disclosed as having a mean particle size of 20 to 2000  $\mu\text{m}$ . See col. 2, lines 53-59 of Nyssen.

At col. 3, lines 1-65, Nyssen discusses exemplary inorganic and organic pigments; note that these pigments are also disclosed in Gonzalez-Blanco et al. at col. 6, line 34 to col. 7, line 12.

Because Nyssen discloses pigment preparations comparable to that of Gonzalez-Blanco et al., said preparations having a particle size comparable to that instantly claimed, one skilled in the art would find reasonable expectation that the pigment preparations of Gonzalez-Blanco et al. would exhibit a particle size within Applicants' claimed range, absent the showing of convincing evidence to the contrary.

With respect to the claimed surface area, one of ordinary skill in the art would also find reasonable expectation that the prior art pigment preparations would also exhibit this property, since the references teach pigment preparations containing the same components as those respectively recited in Applicants' claims, also in percentage amounts reading upon those respectively recited in Applicants' claims. Further, It is well settled that when a claimed composition appears to be substantially the same as a composition disclosed in the prior art, the burden is properly upon the applicant to prove by way of tangible evidence that the prior art composition does not necessarily possess characteristics attributed to the CLAIMED composition. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Circ. 1990); In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); In re Swinehart, 439 F.2d 2109, 169 USPQ 226 (CCPA 1971).

Where the claimed and prior art compounds possess a close structural relationship and a specific significant property in common which renders the claimed



compounds obvious to one skilled in the art, they are effectively placed in the public domain and unpatentable per se, even though the applicant has discovered that they possess an additional activity. In re Mod, et al. (CCPA 1969) 408 F2d 1055, 161 U. S. P. Q. 281.

### *Response to Arguments*

In response to Applicants' arguments that the prior art no longer reads upon Applicants' claims in their present form, said claims now drawn to a **solid pigment preparations**, it is the Examiner's position that, because the claims recite the limitation "including as essential constituents", additional components, such as water, are not excluded from the claimed invention, provided that said additional components do not detrimentally effect the claimed preparations. The term "including" may include elements other than those specified and is synonymous with "comprising". *Ex parte Russell*, 153 USPQ 752 (PO BdPatApp 1966), *Ex parte Davis*, 80 USPQ 448 (PO BdPatApp 1949), *In re Bertsch*, 56 USPQ 379 (CCPA 1942).

Further, although the instant claims recite the requirement that the sum total of the weight percentages not exceed 100% by weight, the respective percentage ranges for components A, B, and C are not fully commensurate with this requirement. For example, if the preparation comprises 90% of component A, the sum totals of components B and C, based on their respective percentage ranges, exceed the remaining 10%, i.e., any amount of component C causes the amount of component B to be outside

the range of "from 10 to 40%" (that is, less than 10%), and this percentage range of component B does not permit any amount of component C to be present in the preparation (i.e., 10% of component B means **zero percent** of component C). Because the prior art reads upon the instant claims, in terms of components and the respective percentage amounts thereof, the physical state of the claimed pigment preparations is deemed within the purview of the prior art.

In response to Applicants' arguments that Gonzalez-Blanco et al. disclose "particular preference...to their use separately", the reference also discloses that "**at least one dispersant**" (col. 1, lines 36-38; emphasis added). Teachings of a reference are not limited to a preferred embodiment. In re Boe, 145 U.S.P.Q. 507 (CCPA 1966).

The same reasoning applies to Nyssen, regarding the disclosure of anionic surface-active agents.

With respect to the maintained double-patenting rejection, the "anionic surface-active additive based on sulfonates, sulfates, phosphonates, or phosphates" recited in this instant claims is considered encompassed by "based on acid phosphoric, phosphonic, sulfuric and/or sulfonic esters of polyalkylene oxides" and "phosphoric and/or phosphonic ester" in claim 1 of the '345 application.

For these reasons, Applicants' arguments are not persuasive, and the rejections of record are maintained.

***Priority***

5. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Applicants' Priority Documents were filed on July 26, 2004.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

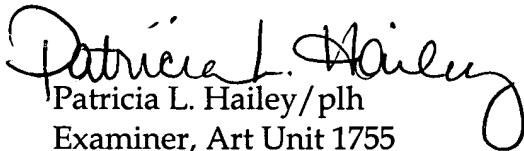
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Hailey whose telephone number is (571) 272-1369. The examiner can normally be reached on Mondays-Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 1700 Receptionist, whose telephone number is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Patricia L. Hailey/plh  
Examiner, Art Unit 1755  
May 4, 2006

  
J.A. LORENZO  
SUPERVISORY PATENT EXAMINER